Cargill Incorporated v Pendaftar Cap Dagangan

HIGH COURT (KUALA LUMPUR) — ORIGINATING SUMMONS NO 24IP-1–01 OF 2013
UMI KALTHUM J
23 AUGUST 2013

Trade Marks — Registration — Application for — Opposition to application — Decision of registrar to refuse registration for the mark 'POULTRY FOCUS' in Class 31 — Appeal against — Whether not an invented word — Whether words having direct reference to character or quality of goods — Whether mark not distinctive — Trade Marks Act 1976 ss 10(1)(c), (d), (e), & 25(5) — Rules of Court 2012 O 87

On 17 July 2002 the plaintiff applied to the registrar of trademarks ('the Registrar') to register the trademark 'POULTRY FOCUS' in Class 31 in respect of 'non-medicated animal feeds' ('the plaintiff's application'). The defendant objected to the plaintiff's application on the grounds that the plaintiffs application did not comply with the Trade Marks Act 1976 ('the Act'), in particular the following reasons: (i) the proposed trademark was not an invented word and therefore did not comply with s 10(1)(c) of the Act; (ii) the proposed trademark comprised of words having direct reference to the character or quality of the goods for which registration was sought namely non-medicated animal feeds and therefore did not comply with s 10(1)(d) of the Act; and (iii) the proposed trademark was not distinctive as its meaning has a direct reference to the character or quality of the goods for which registration was sought namely 'non-medicated animal feeds' and therefore did not comply with s 10(1)(e) of the Act. The plaintiff filed this appeal pursuant to s 25(2) of the Act and O 87 of the Rules of Court 2012 against the decision of the registrar in refusing the plaintiff's trademark application.

Held, allowing the plaintiff's appeal with no order as to costs:

(1) The proposed trademark 'POULTRY FOCUS' was an invented word within the meaning of s 10(1)(c) of the Act. The combination of the words 'POULTRY' and 'FOCUS' may allude to the product sold by the plaintiff, but of themselves these words together cannot per se be said to describe the said product as the word 'FOCUS' has no real connection to the said product. This combination of the two words does not exist in the English language (see paras 9–10).

(2) The registrar had given an interpretation of the two words which the understanding/meaning of the combination of the two words

'POULTRY FOCUS'. 'POULTRY FOCUS' had no direct reference to the character or quality of the plaintiff's goods for which the registration was sought, namely 'non-medicated animal feeds'. Even if the trademark 'POULTRY FOCUS' did somewhat refer to the character or quality of the goods, it was an indirect one and therefore permissable to be registered under s 10(1)(d) of the Act (see para 27).

(3) The plaintiff's mark 'POULTRY FOCUS' was distinctive within the meaning of s 10(1)(e) read together with the definition of 'distinctive' in s 10(2A) of the Act. The words 'POULTRY FOCUS' were not only an inventive word but also distinctive of the plaintiff's goods. The mark 'POULTRY FOCUS' was in larger font from that of the words 'Cargill Animal Nutrition' and therefore it was a distinctive mark in itself in respect of specific goods or range of goods offered by the plaintiff (see paras 29 & 33).

(4) Since the plaintiff's mark was distinctive, there was no need for the plaintiff to prove there existed a secondary meaning to 'POULTRY FOCUS' (see para 34).

(5) The plaintiff's mark had satisfied that it was an invented mark under s 10(1)(c) of the Act, and/or it had no direct reference to the character or quality of the goods under s 10(1)(d) of the Act, and/or it was a distinctive mark under s 10(1)(e) of the Act. The said mark was therefore registrable under any of the said provisions of the Act (see para 35).

[Bahasa Malaysia summary

Pada 17 Julai 2002 plaintif memohon kepada pendaftar cap dagangan ('Pendaftar') untuk mendaftarkan cap dagangan 'POULTRY FOCUS' dalam Kelas 31 berkenaan dengan 'non-medicated animal feeds' ('permohonan plaintif'). Defendan membantah permohonan plaintif atas alasan bahawa permohonan plaintif tidak mematuhi Akta Cap Dagangan 1976 ('Akta'), khususnya atas sebab-sebab berikut: (i) cap dagangan yang dicadangkan adalah perkataan yang tidak dicipta dan oleh itu tidak mematuhi s 10(1)(c) Akta; (ii) cap dagangan yang dicadangkan terdiri daripada perkataan yang merujuk langsung dengan sifat atau kualiti barang-barang yang ingin didaftarkan iaitu 'non-medicated animal feeds' dan oleh itu tidak mematuhi s 10(1)(d) Akta, dan (iii) cap dagangan yang dicadangkan tidak mempunyai ciri tersendiri memandangkan maksudnya mempunyai hubungan langsung dengan sifat atau kualiti barang-barang yang ingin didaftarkan iaitu 'non-medicated animal feeds' dan oleh itu tidak mematuhi s 10(1)(e) Akta. Plaintif telah memfailkan rayuan menurut s 25(5) Akta dan A 87 Kaedah-Kaedah Mahkamah 2012 terhadap keputusan pendaftar yang menolak permohonan cap dagangan plaintif.

Diputuskan, membenarkan rayuan plaintif dengan tiada perintah terhadap kos:

(1) Cap dagangan yang dicadangkan 'POULTRY FOCUS' adalah perkataan yang dicipta dalam maksud s 10(1)(c) Akta. Gabungan perkataan 'POULTRY' dan 'FOCUS' mungkin menggambarkan produk yang dijual oleh plaintif, tetapi sekiranya merujuk kepada perkataan itu sendiri perkataan itu bersama-sama tidak boleh dikatakan menggambarkan produk tersebut seperti perkataan 'FOCUS' tidak mempunyai kaitan sebenar kepada produk. Gabungan kedua-dua perkataan itu tidak wujud dalam bahasa Bahasa Inggeris (lihat perenggan 9–10).

(2) Pendaftar telah memberi tafsiran bagi kedua-dua perkataan jauh melebihi pemahaman/pengertian gabungan daripada dua perkataan 'POULTRY FOCUS'. 'POULTRY FOCUS' tidak mempunyai hubungan langsung dengan sifat atau kualiti barangan plaintif yang ingin didaftarkan, iaitu 'non-medicated animal feeds'. Walaupun cap dagangan 'POULTRY FOCUS' agak merujuk kepada sifat atau kualiti barang-barang, ia adalah secara tidak langsung dan oleh itu dibenarkan untuk didaftar di bawah s 10(1)(d) Akta (lihat perenggan 27).

(3) Cap dagangan plaintif 'POULTRY FOCUS' mempunyai ciri tersendiri dalam tafsiran s 10(1)(e) dibaca bersama dengan definisi 'distinctive' di bawah s 10(2A) Akta. Perkataan 'POULTRY FOCUS' bukan sahaja perkataan yang direka cipta tetapi juga menunjukkan ciri tersendiri barangan plaintif. Tanda 'POULTRY FOCUS' adalah dalam font yang lebih besar daripada perkataan 'Cargill Animal Nutrition' dan oleh itu merupakan tanda yang tersendiri merujuk kepada barang-barang atau pelbagai barangan tertentu yang ditawarkan oleh plaintif (lihat perenggan 29 & 33).

(4) Oleh kerana tanda plaintif adalah tersendiri, tidak ada keperluan untuk plaintif membuktikan kewujudan maksud lain bagi 'POULTRY FOCUS' (lihat perenggan 34).

(5) Cap dagangan plaintif telah memenuhi kehendak bahawa ia adalah satu tanda dicipta di bawah s 10(1)(c) Akta, dan/atau ia tidak mempunyai hubungan langsung dengan sifat atau kualiti barang di bawah s 10(1)(d), dan/atau ia adalah tanda yang tersendiri di bawah s 10(1)(e) Akta. Tanda tersebut oleh itu boleh didaftarkan di bawah mana-mana peruntukan Akta (lihat perenggan 35).]

Notes

For cases on application for registration, see 12(2) *Mallal's Digest* (4th Ed, 2013 Reissue) paras 2627–2631.

Cases referred to

American Screw Co's Application No 773098 for Registration of Trade Mark, Re [1959] RPC 344, Ch D (refd)

Eastman Photographic Materials Company (1898) 15 RPC 476 (refd)

Illinois Tool Works, Inc v Pendaftar Cap Dagangan (M) [2009] 9 MLJ 101, HC (refd)

In the matter of an application by the Diamond T Motor Car Co (1921) 38 RPC 373 (refd)

Oze Marketing Sdn Bhd v Twenty First Century Products Sdn Bhd [1999] 4 MLJ 449, HC (refd)

Philippart v William Whiteley Ltd, Re Philippart's Trade Mark Diabolo (1908) 25 RPC 565 (refd)

Procter and Gamble Company v OHIM (case C-383/99 P) (refd)

Service Master (M) Sdn Bhd v MHL Servicemaster Sdn Bhd & Anor and another application [1998] 5 MLJ 378, HC (refd)

W & G du Cros Ltd's Applications [1913] 30 RPC 660 (refd)

Wembley Gypsum Products Sdn Bhd v MST Industrial Systems Sdn Bhd [2007] 7 MLJ 193,CA (refd)

Yong Sze Fan & Anor v Sharifah binti Mohd Tamin & Ors [2008] 7 MLJ 803, HC (refd)

Legislation referred to

Rules of Court 2012 O 87
Trade Marks Act 1976 ss 10(1), 10(1)(a), (b), (c), (d), (e), (2A), 25(3), (5), 27
Trade Marks Regulations 1997 reg 75(1)

Jamini Rajeswaran (Soh Peng Hui with her) (Sreenevasan) for the plaintiff.
Iylia bt Hashim (Intelectual Property Corporation of Malaysia) for the defendant.

Umi Kalthum J:

THE APPEAL

[1] This is the plaintiff's appeal pursuant to s 25(5) of the Trade Marks Act 1976 ('the Act') and O 87 of the Rules of Court 2012 against the decision of the registrar of Trademarks ('the registrar') dated 11 December 2012 wherein the registrar had refused the plaintiff's Trademark Application No 02008431 to register the trademark 'POULTRY FOCUS' in Class 31 in respect of 'non-medicated animal feeds'.

[2] The originating summons ('encl 1') filed by the plaintiff prays for the following orders:

(1) an order that the decision of the registrar dated 11 December 2012 pursuant to s 25(3) of the Act refusing the plaintiff's Trademark Application No 02008431 for 'POULTRY FOCUS' in Class 31 in respect of non-medicated animal feeds be set aside;

(2) an order that the Trademark Application No 02008431 be accepted by the registrar;

(3) an order that the Trademark Application No 02008431 be advertised in the prescribed manner pursuant to s 27 of the Act;

(4) in the event that the above prayers are granted, a copy of this order be served on the registrar in accordance with reg 75(1) of the Trade Marks Regulations 1997;

(5) costs.

THE BACKGROUND

[3] On 17 July 2002 the plaintiff applied to the registrar to register the trademark 'POULTRY FOCUS' in Class 31 in respect of 'non-medicated animal feeds' ('the plaintiff's application').

[4] The defendant objected to the plaintiff's application vide letter dated 6 November 2003 on the grounds that the plaintiffs application did not comply with the Act, in particular the following reasons:

(1) the proposed trademark was not an invented word and therefore did not comply with s 10(1)(c) of the Act;

(2) the proposed trademark comprised of words having direct reference to the character or quality of the goods for which registration was sought namely non-medicated animal feeds and therefore did not comply with s 10(1)(d) of the Act;

(3) the proposed trademark was not distinctive as its meaning has a direct reference to the character or quality of the goods for which registration was sought namely 'non-medicated animal feeds' and therefore did not comply with s 10(1)(e) of the Act.

[5] The plaintiff via letter dated 13 November 2003 responded to the defendant's objections stating that the objections were without merits. The defendant maintained their objections against the plaintiff's application based on s 10(1)(c), (d) and (e) of the Act vide letter dated 28 October 2005 but gave

opportunity to the plaintiff to request for a hearing. On 25 January 2006 the plaintiff requested for a hearing to be held in respect of defendant's objections to the plaintiffs application. The hearing took place on 5 May 2010.

[6] Vide letter dated 31 May 2010, the defendant informed the plaintiff that the plaintiffs application was refused as it did not satisfy the requirements of s 10(1) of the Act ('the decision'). In para 48 at p 16 of the grounds of decision the learned *Penolong Pendaftar Cap Dagangan* stated his decision as:

> Cap dagangan pemohon bukanlah perkataan yang direkacipta tetapi merupakan perkataan kombinasi perkataan biasa iaitu POULTRY dan FOCUS yang terdapat didalam kamus. Cap dagangan pemohon juga merujuk secara langsung kepada barangan yang dipohon pemohon. Cap dagangan POULTRY FOCUS juga adalah tidak distintif kerana gagal mencapai status 'secondary meaning'. Oleh yang demikian, permohonan ini sewajarnya ditolak kerana tidak memenuhi kehendak Seksyen 10 ACD 1976.

THE DECISION

[7] For ease of reference the provisions of s 10(1) of the Act is reproduced below:

> (1) In order for a trade mark (other than a certification trade mark) to be registrable it shall contain or consist of at least one of the following particulars:
>
> (a) the name of an individual, company or firm represented in a special or particular manner;
>
> (b) the signature of the applicant for registration or of some predecessor in his business;
>
> (c) an invented word or words;
>
> (d) a word having no direct reference to the character or quality of the goods or services not being, according to its ordinary meaning, a geographical name or surname; or
>
> (e) any other distinctive mark.

[8] It is not disputed that the plaintiffs proposed mark 'POULTRY FOCUS' does not fall within s 10(1)(a) and (b) of the Act. Only one condition is needed to be satisfied for the proposed mark to be considered registrable (see *Yong Sze Fan & Anor v Sharifah binti Mohd Tamin & Ors* [2008] 7 MLJ 803). I will then consider whether the plaintiff's proposed mark can be registrable under s 10(1)(c), (d) and/or (e) of the Act.

Section 10(1)(c) — an invented word or words

[9] The plaintiff submitted that the trademark 'POULTRY FOCUS' is an invented word and therefore registrable under s 10(1)(c) of the Act. In support of its contention, the plaintiff relied on the case of *Illinois Tool Works, Inc v Pendaftar Cap Dagangan (M)* [2009] 9 MLJ 101, where His Lordship Ramly J held that, at p 111, paras 35 and 37:

> [35] What this means is that an invented word can have a meaning as long as the meaning is not obvious and does not deprive members of the trade from using it to describe the character or quality of the goods.
>
> [37] Therefore, an application may be allowed under the law to have some meaning in its mark and that meaning is acceptable if it is a covert and skilful allusion to the character or quality of the goods. What this means is that the meaning of the mark is not so obvious to the character or quality of the goods. If the trademark has an indirect meaning (covert and skilful allusion) it is permissable.

[10] It was submitted that whilst 'poultry' and 'focus' are common English words, they are nevertheless an invented word when combined together as the combination does not convey an obvious meaning and does not deprive the members of the trade from using it to describe the character or quality of the goods. It is trite law that a trademark must be considered as a whole (see *Illinois Tool works Inc* and *In the matter of an application by the Diamond T Motor Car Co* (1921) 38 RPC 373). The word 'focus' is not a word commonly or normally used with the word 'poultry' in the English language. The defendant himself had admitted that the combination cannot be found in the dictionary (para 19, pp 139–140, AR of grounds of decision). It was further submitted that 'POULTRY FOCUS' is in fact an unusual juxtaposition and is not a familiar, common, normal or usual combination or expression in the English language whether in relation to 'non-medicated animal feeds' or otherwise and that the word 'poultry' is not one which would be used with the word 'focus'. As such when used together, 'POULTRY FOCUS' does not convey an obvious meaning, even though it may convey a covert and skillful allusion which is permissable as illustrated in *Illinois Tool Works, Inc*'s case.

[11] This unusual juxtaposition of words, it was submitted, is not a combination of words that any trader would seek to use to describe 'non-medicated animal feeds'. It therefore will not deprive any members of the trade from using it to describe the character or quality of the goods. The defendant in fact had acknowledged that there is no evidence of other traders using the combination 'POULTRY FOCUS' (para 17, p 139, AR, grounds of decision). The Court of Appeal case of *Wembley Gypsum Products Sdn Bhd v MST Industrial Systems Sdn Bhd* [2007] 7 MLJ 193 was cited as the authority

on the trademarks 'PINHOLE', 'SAKURA' and 'FISSURED' were invented words as they were substantially new when first used by the respondent. A

[12] Also, the defendant had in fact registered the plaintiff's trademarks 'AQUA FOCUS' and 'PORK FOCUS' in respect of 'non-medicated feeds' which in itself establishes that such combinations are registrable under s 10(1)(a) of the Act. The case of *Illinois Tool Woks, Inc* was cited to stress this point, where the learned J had held, at pp 117–118, para 69, that: B

> [69] … the registrar had already accepted (in 2002) that the appellant's trademark was indeed distinctive, inventive and had no direct reference to the character or quality of the goods (silicone). This fact is therefore relevant and significant. The registrar had summarily dismissed the fact that the appellant has already secured registration and proprietorship of its trade mark 'HIGH TEMP RED' via its registered trademark No 02005833. This would render the registrar's refusal to register the appellant's registration of its current trademark irrational and the court is obliged to interfere to rectify this mistake. C D

[13] It was the submission of the defendant that the words 'POULTRY FOCUS' is not an invented word as the word conveys an obvious meaning to the ordinary man which is directly describing the plaintiffs goods. When both words 'POULTRY FOCUS' are read together as a whole, it is too obvious that the words would be understood and perceived as 'focusing on poultry'. This is due to the word 'FOCUS' which is laudatory in nature that further emphasize the meaning of the word 'POULTRY' instead of deriving a new or different meaning. Reference was made to the decision of Lord Herschell in the House of Lords' case of *Eastman Photographic Materials Company* (1898) 15 RPC 476 at p 485, lines 35–44, as follows: E F

> … I don't think the combination of two English words is an invented word, even although the combination may not have been in use before, nor do I think that a mere variation of the orthography or termination of a word would be sufficient to constitute an invented word, if to the eye or ear the same idea would be conveyed as by the word in its ordinary form … G

[14] The defendant submitted that when the two words 'POULTRY FOCUS' are put next to each other it would surely compute a meaning in the minds of of the public as 'focusing on poultry'. Therefore these words cannot be invented words as invented words do not carry any meaning based on the decision of Parker J in *Philippart v William Whiteley Ltd, Re Philippart's Trade Mark Diabolo* (1908) 25 RPC 565. I am unable to accept this reference by the defendant as the case quoted is not in the Bundle of Authorities of the defendant. Further, the word 'POULTRY' means 'animal' (as in 'chickens, turkeys, ducks and geese' based on its definition in the *Oxford Dictionary*, *Thesaurus* and *Wordpower Guide*) whilst the word 'FOCUS' when put next to H I

it does not create any less impact for the word to be perceived as 'POULTRY', and in this manner 'POULTRY' directly describes the defendant's goods. There is no covert or skillful allusion in this application to enable the plaintiff's mark 'POULTRY FOCUS' to be registered.

[15] Even though the defendant admitted that the word 'POULTRY FOCUS' cannot be found appearing side by side in the English dictionary, the defendant submitted that it does not change the fact that these words when read together convey an obvious meaning which is directly describing the goods of the plaintiff contrary to the requirements of the law vis s 10(1)(c) of the Act.

[16] I am more inclined to agree with the submissions of the plaintiff. I am of the view that the proposed trademark 'POULTRY FOCUS' is an invented word within the meaning of s 10(1)(c) of the Act. The combination of the words 'POULTRY' and 'FOCUS' may allude to the product sold by the plaintiff, but of themselves these words together cannot per se be said to describe the said product as the word 'FOCUS' has no real connection to the said product (see *Illinois Tool Works, Inc*'s case). This combination of the two words does not exist in the English language. It is therefore not surprising that no other persons in the trade have seen it fit to use the same combination of words to describe their products nor to apply for their marks to be registered using the same combination of words (see *Wembley Gypsum Products Sdn Bhd*'s case).

[17] I am also unable to accept the submission of the defendant that the combination of these words is not inventive since the defendant had seen it fit to register the plaintiff's trademarks in 'PORK FOCUS' and 'AQUA FOCUS', under Class 31 pursuant to Trade Mark Registration No 02008434 and No 02008437 respectively (see exh 'A-10', affidavit affirmed by Kwan Chew Yung on 27 February 2013, encl 4). Puan Badiah bt Abbas, the assistant registrar of trademarks, in para 14 of her affidavit in reply affirmed on 7 February 2013 (encl 3) had averred that there are other traders who are interested to use the words 'POULTRY' and 'FOCUS' either as a whole or separately and had tendered several exhibits in eks 'D-2' as her evidence of this averment. Upon my perusal of her exhibits, what is mainly common in the mark registered/to be registered is, except for 'PORK FOCUS', the use of the word 'POULTRY', as in 'POULTRY FOOD MIXTURE' (withdrawn), 'IPI INTEGRATED POULTRY INDUSTRY' (renewal pending), 'PORK FOCUS' (registered), 'ROSE POULTRY' (under examination), 'TMC BUTCHERY PORK.BEEF.LAMB.POULTRY'(under consideration), 'PPNJ POULTRY & MEAT SDN BHD' (registered), 'POULTRYSTAR' (registered), and 'TRIMIX POULTRY CONCENTRATE' (withdrawn). None of these

exhibits showed the mark to be a combination of two words 'POULTRY FOCUS'. Incidentally, the owner of the registered trademark 'PORK FOCUS' is the plaintiff itself.

[18] I would echo the words of Ramly J in the case of *Illinois Tool Works, Inc* as quoted in para 11 above when His Lordship thought it was relevant and significant fact, as I find in this case, that the registrar had already accepted in 2002 that the appellant's trademark was distinctive, inventive and had no direct reference to the character or quality of the goods. When the registrar had refused to register the appellant's registration of its current trademark, His Lordship found, as I find in this case, the refusal as irrational and the court is obliged to interfere and rectify the mistake.

Section 10(1)(d) — a word having no direct reference to the character/quality of goods

[19] It was submitted for the plaintiff that the tradmark 'POULTRY FOCUS' has no direct reference to the character or quality of the goods for which the registration is sought for, namely 'non-medicated animal feeds'. It is not a word according to its original meaning a geographical name or surname and it is thus registrable under s 10(1)(d) of the Act. The trademark 'POULTRY FOCUS' does not convey that the plaintiff's animal feeds are of good quality or that they are nutritional from the perspective of 'nutritional concentration, ingredient digestibility and effective medication' or that they had greater advantages and benefits as compared to other animal feeds and as alleged by the defendant in paras 31, 32 of the grounds of decision, p 143, AR.

[20] If the trademark 'POULTRY FOCUS' refers to the character or quality of the goods, it is an indirect one as opposed to direct, and based on *Illinois Tool Works, Inc*'s, the trademark is registrable under s 10(1)(d) of the Act. Reference was also made to the case of *In the Matter of American Screw Coy's Application No.773, 098 for the Registration of a Trade Mark* [1959] RPC 344, where Lloyd-Jacob J held at p 346 that 'direct reference corresponds in effect to aptness for normal description'. In that case, His Lordship had held that whilst the trademark 'Torque-set' was not intrinsically devoid of reference to the character of its goods, namely screws, bolts, rivets and studs and fastening devices, such would not amount to 'direct reference' to the character or quality of the goods.

[21] Since it has been shown that no other traders have used this combination of words (para 17, grounds of decision, p 139, AR), the registration of 'POULTRY FOCUS' by the plaintiff will not deprive any

members of the trade from using it to describe the character or quality of the goods, as a combination it is not apt for the normal description of the goods in question.

[22] Further, since the defendant had in fact registered the plaintiff's trademarks 'AQUA FOCUS' and 'PORK FOCUS' in respect of 'non-medicated animal feeds', the said registration in itself establishes that such combinations are registrable under s 10(1)(d) of the Act.

[23] For the defendant, it was submitted that the word 'POULTRY FOCUS' is directly referring to the character of the plaintiff's goods which are directly related to poultry or animal.

[24] Further, due to the laudatory nature of the word 'FOCUS', it inadvertently means that the words 'POULTRY FOCUS' when coined together are interrelated to each other with the connotation of 'focusing on poultry'. That words which are descriptive or words having direct reference to the goods are common property and therefore cannot be monopolised by any person as held by Lord Herschell in *Eastman Photographic Materials Company* p 484:

> … The vocabulary of the English language is common property; it belongs alike to all; and no one ought to be permitted to prevent the other members of the community from using, for purposes of description, a word which has reference to the character or quality of the goods.

Therefore, the defendant submitted that the words 'POULTRY FOCUS' are common English words and cannot be monopolised solely by the plaintiff.

[25] The defendant then referred to the instances where traders in the poultry industry had applied to register trademarks bearing the words 'POULTRY FOCUS' and which I have referred to earlier in para 15 above. It was the defendant's submission that the instances referred to show that many traders intend to use the word 'POULTRY' in respect of their products and therefore the word 'POULTRY' should not be monopolised by the plaintiff only.

[26] Once again I am more inclined to accept the plaintiff's submission on this aspect for the reasons I have earlier alluded in respect of s 10(1)(c) of the Act. I am of the view that the assistant registrar in his grounds of decision at paras 31 and 32, p 143 AR, had given an interpretation of the two words which far exceed the understanding/meaning of the combination of the two words 'POULTRY FOCUS' when he stated as follows:

31. Sekiranya orang awam melihat cap dagangan POULTRY FOCUS, orang awam akan segera mengetahui bahawa barangan yang diniagakan adalah makanan ternakan binatang. Orang awam juga akan segera tahu bahawa jika mereka memilih barangan pemohon, mereka akan dapat makanan ternakan yang berkualiti dan berkhasiat dari segi nutritional concentration, ingredients digestibility, effective medication dan sebagainya. Di dalam industri penternakan ayam umpamanya pemakanan yang berzat akan dapat memberi kesihatan yang baik yang menghasilkan pembesaran anak ayam yang maksima.

32. Perkataan POULTRY FOCUS yang bermaksud Memfokuskan Untuk Penternakan sememangnya merujuk kepada sifat barangan yang diniagakan pemohon. Meletakkan perkataan FOCUS setelah perkataan POULTRY tidak lain adalah untuk memberi gambaran atau menunjukkan makanan binatang pemohon mempunyai banyak kelebihan dan kebaikan berbanding dengan makanan binatang yang lain di pasaran.

[27] Even by a stretch of the imagination, I am unable to agree with his interpretation of the said words. I agree with the submission of the plaintiff that 'POULTRY FOCUS' has no direct reference to the character or quality of the plaintiff's goods for which the registration is sought, namely 'non-medicated animal feeds'. Even if the trademark 'POULTRY FOCUS' does somewhat refer to the character or quality of the goods, it is an indirect one and therefore permissable to be registered under s 10(1)(d) of the Act (see *Illinois Tool Works, Inc* and *Re American Screw Co's Application No 773098 for Registration of Trade Mark*).

Section 10(1)(e) — any other distinctive mark

[28] The word 'distinctive' has been defined in s 10(2A) of the Act as:

… in relation to the trade mark registered or proposed to be registered in respect of goods or services, means the trade mark must be capable of distinguishing goods or services with which the proprietor of the trade mark is or may be connected in the course of trade from goods or services in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered, subject to conditions, amendments, modifications or limitations, in relation to use within the extent of the registration.

[29] It was the plaintiff's submission that the trademark 'POULTRY FOCUS' is distinctive within the meaning of the said definition and thus registrable under s 10(1)(e) of the Act. Reference was made to the House of Lords case of *W & G du Cros Ltd's Applications* (1913) 30 RPC 660 per Lord Parker at pp 671–672, who held that:

… in order to determine a mark is distinctive it must be considered quite apart from the effects of registration. The question, therefore, is whether the mark itself, if used as a Trade Mark, is likely to become actually distinctive of the goods of the persons

so using it. The applicant for registration in effect says, I intend to use this mark as a Trade Mark, ie, for the purpose of distinguishing my goods from the goods of other persons, and the registrar or the Court has determine, before the mark be admitted to registration, whether it is of such a kind that the applicant, quite apart from the effects of registration, is likely or unlikely to attain the object he has in view. The applicant's chance of success in this respect must, I think, largely depend upon whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods …

[30] Reference was also made to the American case of *Procter and Gamble Company v OHIM* (case C-383/99 P)where it was held that

> In order to assess whether a word combination such as BABY-DRY is capable of distinctiveness, it is therefore necessary to put oneself in the shoes of an English-speaking consumer. From that point of view, and given that the goods concerned in this case are babies' nappies, the determination to be made depends on whether the word combination in question may be viewed as a normal way of referring to the goods or of representing their essential characteristic in common parlance …
>
> Whilst each of the two words in the combination may form part of expressions used in everyday speech to designate the function of babies' nappies, their syntactically unusual juxtaposition is not a familiar expression in the English language, either for designating babies' nappies or for describing their essential characteristics.
>
> Word combinations like BABY-DRY cannot therefore be regarded as exhibiting, as a whole, descriptive character; they are lexical inventions bestowing distinctive power on the mark so formed and may not be refused registration …

[31] The plaintiff therefore submitted that the trademark 'POULTRY FOCUS' is inherently distinctive for the following reasons:

(a) the combination 'POULTRY FOCUS' is in fact an unusual juxtaposition syntactically and is not a familiar, common, normal or usual combination or expression in the English language whether in relation to 'non-medicated animal feeds' or otherwise;

(b) when used together, 'POULTRY FOCUS' does not convey a direct reference to the character or quality of the goods namely 'non-medicated animal feeds' as it is a combination which is apt for the normal description of 'non-medicated animal feeds';

(c) no other traders has used this combination of words;

(d) no other trader is likely in the ordinary course of business and without improper motive to desire to use the same mark;

(e) refuting the defendant's contention, that the plaintiff's trademark

'POULTRY FOCUS' cannot function as a trademark and is thus not distinctive as when compared to the words 'Cargill Animal Nutrition' on the plaintiff's packaging, the plaintiff's trademark 'POULTRY FOCUS' on the plaintiff's packaging is in larger font than 'Cargill Animal Nutrition' as can be seen clearly in the packaging at pp 151–153, exh 'A-9', the plaintiff's affidavit No 1. Further, it is common for products to bear a house mark as well as another trademark used specifically for a particular product or range of products, for example, 'Nestle' is the house mark, whilst 'Nutren', 'Kit Kat', 'Milo', and ' Coffee-Mate' are other trademarks used for different products offered. So in this case, 'Cargill Animal Nutrition' is clearly the house mark whilst 'POULTRY FOCUS' clearly functions as a trademark in respect of specific goods or range of goods;

(f) the fact that the defendant had registered the plaintiff's trademarks 'AQUA FOCUS' and 'PORK FOCUS' in respect of 'non-medicated animal feeds' in itself establishes that such combinations are registrable under s 10(1)(e) of the Act.

[32] For the defendant, it was submitted that the plaintiff mark 'POULTRY FOCUS' is highly descriptive of the goods and is prone to be used by other traders in the poultry industry. Therefore the plaintiff's mark 'POULTRY FOCUS' is not inherently capable of distinguishing from its goods. Further, it was submitted that the said words which are descriptive cannot be distinctive unless such words have acquired a secondary meaning (*Service Master (M) Sdn Bhd v MHL Servicemaster Sdn Bhd & Anor and another application* [1998] 5 MLJ 378; *Oze Marketing Sdn Bhd v Twenty First Century Products Sdn Bhd* [1999] 4 MLJ 449), and this the plaintiff has failed to prove that its trademark has achieved a secondary meaning. The defendant therefore submitted that the plaintiff's mark cannot be distinctive and does not qualify to be registered under s 10(1)(e) of the Act.

[33] I agree with the submissions of the plaintiff that the plaintiff's mark 'POULTRY FOCUS' is distinctive within the meaning of s 10(1)(e) read together with the definition of 'distinctive' in s 10(2A) of the Act. Once again the defendant had failed to make a distinction between the common use of the word 'POULTRY' as against the juxposition of the words 'POULTRY FOCUS' as claimed to be the trademark of the plaintiff, which I find to be not only an inventive word but also distinctive of the plaintiff's goods. exh 'A-9' of the plaintiff's affidavit in support is evidence of the plaintiff's usage of the said trademark on its packaging of animal feeds. I agree that the mark 'POULTRY FOCUS' is in larger font from that of the words 'Cargill Animal Nutrition' and therefore it is a distinctive mark in itself in respect of specific goods or range of goods offered by the plaintiff.

[34] As I find that the plaintiff's mark is distinctive, there is no need for the plaintiff to prove there exists a secondary meaning to 'POULTRY FOCUS'.

THE CONCLUSION

[35] For the reasons stated above, I allow the plaintiff's appeal and the prayers sought in the originating summons with no order as to costs. I hold that the plaintiffs mark has satisfied that it is an invented mark under s 10(1)(c) of the Act, and/or it has no direct reference to the character or quality of the goods under s 10(1)(d) of the Act, and/or it is a distinctive mark under s 10(1)(e) of the Act. The said mark is therefore registrable under any of the said provisions of the Act.

Plaintiff's appeal allowed with no order as to costs.

Reported by Kanesh Sundrum